

I. The Restriction Requirement Is Traversed

A. The Claimed Invention

Claim 1 recites

1. A method for manufacturing a bipolar transistor by using a CMOS process, comprising:
 - performing a high voltage deep well and drive-in process on a semiconductor substrate;
 - performing a local oxidation of silicon (LOCOS) process;
 - performing an Nbase and Pbase process;
 - forming logic N well and P well and annealing the logic wells;
 - forming a poly gate and sequentially forming NMOS/PMOS LDD source/drain; and
 - forming N+/P+ source/drain, annealing the source/drain and sequentially performing a CONT~PAD process.

See the specification at p. 7. The action alleges that claim 1 falls within Group I. Claim 6 recites:

6. A method for manufacturing a bipolar transistor by using a CMOS process comprising:
 - performing a high voltage deep well and drive-in process on a semiconductor substrate;
 - sequentially performing a local oxidation of silicon (LOCOS) process forming an NMOS well and a PMOS well, and then annealing the logic wells;
 - forming a poly gate and sequentially forming an Nbase/Pbase; and
 - sequentially forming NMOS/PMOS source/drain, forming N+/P+ source/drain, annealing the source/drain and sequentially performing a CONT~PAD process.

See *id.* at p. 7-8. The action alleges that claim 6 falls within Group II.

B. The Restriction

As bases for the restriction, the action alleges the two groups of invention are distinct from one another because:

Currently, there is no generic claim. Group I invention to Group IV [*sic*, Group II] invention are species [*sic*, separate] and distinct, each from the other for the above reasons, in which forming a poly gate and sequentially forming an Nbase/Pbase in Group II.

Because these inventions are species [*sic*, separate] and distinct for the reasons given above and have acquired a separate status **as shown by the above-different classifications** and as given in the above examples, the fields of search are not co-extensive and separate examination would be required, restriction for examination purposes as indicated is proper.

Action at p. 2 (bold-face emphasis supplied). Contrary to the foregoing statement, the action identifies both groups as falling within the same class, i.e., class 438. *See id.*

C. Admissions Concerning the Patentability of the Claims Result if the PTO Maintains the Restriction Requirement

If the restriction requirement is maintained, then the U.S. Patent and Trademark Office (“PTO”) admits that the Group I method is patentable over a disclosure of the Group II method, and vice versa. *See, e.g.*, MPEP § 802.01 (8th Ed., rev. 3, Aug. 2005). These admissions are necessary to the PTO’s entry of the restriction requirement and may be relied upon by the applicant during examination of this application and future divisional applications, unless the restriction requirement is withdrawn. If the PTO is not making these admissions regarding patentability, then the restriction requirement should be withdrawn.

The restriction requirement also should be withdrawn because the restriction may present potential double patenting. According to the MPEP, the patent statute (e.g., 35 USC § 121):

prohibits the use of a patent issuing on an application with respect to which a requirement for restriction has been made, or on an application filed as a result of such a requirement, as a reference against any divisional application, if the divisional application is filed before the issuance of the patent. The 35 U.S.C. 121 prohibition applies only where the Office has made a requirement for restriction. ... This apparent nullification of double patenting as a ground of rejection or invalidity in such cases imposes a **heavy burden** on the Office to guard against erroneous requirements for restrictions where the claims define essentially the same invention in different language and which, if acquiesced in, might result in the issuance of several patents for the same invention.

See MPEP § 804.01 (8th Ed., rev. 3, Aug. 2005) (emphasis added). The applicant respectfully requests reconsideration and withdrawal of the restriction requirement in view of the foregoing admonitions.

D. Search and Examination of the Entire Application Can Be Made Without Serious Burden on the Examiner

The MPEP states that search and examination of the entire application must impose a serious burden on the examiner for restriction to be proper. See MPEP § 803 (8th Ed., rev. 3, Aug. 2005) ("If the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions."). The restriction requirement is traversed because there is no evidence that search and examination of the entire application would impose a serious burden on the PTO.

The claims of Groups I and II are concerned with and recite similar subject matter (e.g., a method for manufacturing a bipolar transistor by using a CMOS process). Indeed, the action itself states that the subject matter of the Group I claims is classified in class 438, and the subject matter of the Group II claims also is classified in class 438. See the Action at p. 2. Accordingly, a complete search directed to the subject matter recited in the claims of Group I would include a search directed to the subject matter recited in the claims of Group II, and vice versa. Searching the same class would not impose a serious burden on the PTO. Indeed, the PTO has not even alleged that there would be a serious burden, in contravention of the guidance set forth at MPEP § 803.

Because search and examination of the entire application can be performed without serious burden on the PTO, it would be wasteful of the time, effort, and resources of both the applicant and the PTO to prosecute the two groups of method claims in separate applications. Furthermore, if the restriction requirement is maintained, the applicant will likely incur additional prosecution costs associated with filing one or more divisional applications, and the PTO will be required to perform duplicative searches. Thus, withdrawal of the restriction requirement will actually **reduce** the burden on the PTO and on the applicants.

In view of the foregoing, the applicant respectfully requests reconsideration and withdrawal of the restriction requirement.

II. Provisional Election

Pursuant to the requirements of 37 CFR § 1.143, the applicant hereby elects the subject matter recited in claims 1-5 (Group I) for further prosecution.

CONCLUSION

Should the examiner wish to discuss the foregoing, or any matter of form or procedure in an effort to advance this application to allowance, the examiner is urged to contact the undersigned attorney.

Respectfully submitted,

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